

REMARKS**Response to Claim Rejections Under 35 U.S.C. §103**

Claims 1, 40-43 and 47-53 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Kieturakis U.S. Pat. No. 5,794,626) in view of Tihon et al. (U.S. Pat. No. 5,415,656) and further in view of Burbank et al. (U.S. Pat. 5,526,822).

Claim 1 calls for four separate driving members, namely three longitudinal driving members having separate functions and one rotating driving member. While the individual references describe one or two driving members, none teach four. The Examiner contends that there is motivation to combine Burbank et al. with Kieturakis and Tihon et al. to fine tune the location of the tissue penetrating distal tip of the shaft. In making this combination, the Examiner seems to contend that those skilled in the art would be motivated to combine any reference as long as it relates to a biopsy device. The biopsy device of Burbank functions entirely differently than either Kieturakis or Tihon et al. Burbank et al. positions the outer member to locate the tissue receiving opening so that part of the lesion can be aspirated into the opening and an inner cutter can remove a tissue specimen. No attempt is made to remove the entire lesion. In applicants' device the shaft is positioned longitudinally to locate the electrosurgical tissue cutting element so as to remove a mass of tissue with the lesion within the mass. To do this the distal end of the tissue cutting element and the proximal end of the tissue cutting element must be respectively distal and proximal to the tissue specimen to ensure removal of the entire lesion. Longitudinal movement of the elongated shaft after placement of the tissue cutting element within the tissue specimen to ensure that the entire lesion is removed is not shown in the prior art.

Claims 44-45 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Kieturakis ('626) in view of Tihon et al. ('656) Burbank et al. ('822), and further in view of Treat (U.S. Pat. No. 4,493,320).

Treat fails to make up for the deficiencies of the Kieturakis, Tihon et al. and Burbank et al.

Reliance Upon "Douglas et al." Reference

On page 7 of the Office Action, reference is made to Douglas et al., but no Douglas et al. reference has been cited in this application. Moreover, it is not clear whether the Examiner intended to include a rejection based upon the Douglas et al. reference.

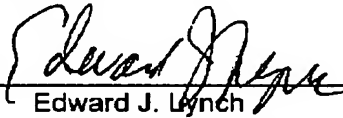
Applicants respectfully request withdrawal of the finality of the Office Action and identification of the Douglas et al. reference so that applicants may have the opportunity to address this reference.

Conclusion

Applicants believe that the presently pending claims are directed to patentable subject matter. Reconsideration and an early allowance are earnestly solicited. In the event that the Examiner believes that the above amendment to the claims does not put the claims in condition for allowance, applicants request that the amendment be entered for purposes of appeal.

Respectfully submitted,

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